



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/631,970

08/01/2003

Daniel Lee Hamilton

23952-0108

3665

72386

7590

04/15/2009

SUTHERLAND II

SUTHERLAND, ASBILL & BRENNAN, LLC

999 PEACHTREE STREET

ATLANTA, GA 30309

EXAMINER

ANDERSON, JOHN A

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

04/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/631,970	Applicant(s) HAMILTON ET AL.	
	Examiner JOHN A. ANDERSON	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,26,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24,26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/24/2004;12/27/2007;01/16/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements dated 02/24/2004, 12/27/2007 and 01/16/2009 has been considered.

Response to Amendment

- 2 In the amendment filed 01/16/2009, the following has occurred: claims 1, 4-12, 15, 18, 23-24 and 26 have been amended. Claims 28-29 have been added. Claims 1-24, 26 and 28-29 are pending and are presented for examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
4. Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganesan et al (PGPub 2002/0087468).
5. As regards claims 1, 12 and 23, Ganesan et al discloses a method comprising

Art Unit: 3696

- executing computer implemented instructions performed by one or more service provider processors for: [0008]
- receiving, at a payment service provider, a payment request for the payment service provider to pay a payee on behalf of a payor;[0007]
- assembling, at the payment service provider, a plurality of risk reduction techniques available for fulfilling the received payment request based at least in part on information included in the received payment request;[0011]
- evaluating, at the payment service provider, each risk reduction technique of the plurality of risk reduction techniques available for fulfilling the received payment request based on at least one predetermined factor associated with each of the plurality of risk reduction techniques;[0075]
- selecting, at the payment service provider, one of the plurality of risk reduction techniques available for fulfilling the received payment request to be used when processing the payment request, wherein the selection is based at least in part on the evaluation of each risk reduction technique; and [0014]
- processing, at the payment service provider, the payment request using the selected risk reduction technique, wherein processing the payment request

includes directing funds to the payee on behalf of the payor.[0016]

6. As regards claims 2 and 13, Ganesan et al discloses wherein each of the plurality of risk reduction techniques reduces a risk of financial loss to the payment service provider in processing the payment request on behalf of the payor. [0019]
7. As regards claims 3 and 14, Ganesan et al discloses wherein the plurality of risk reduction techniques includes at least one of i) determining, prior to directing funds to the payee in association with processing the payment request, that payor funds are available, ii) determining, prior to directing funds to the payee in association with processing the payment request, that an entity is available from which to collect funds if funds cannot be collected from the payor in association with processing the payment request, iii) determining whether payment to the payee will be drawn on a deposit account associated with the payor, or drawn on a deposit account associated with an entity other than the payor, and iv) directing funds to the payee a predetermined period of time subsequent to initiating an electronic debiting of a deposit account associated with the payor. [0011]
8. As regards claims 4 and 15, Ganesan et al discloses wherein the selected risk reduction technique is the determining that payor funds are available, and wherein executing computer- implemented instructions performed by one or

Art Unit: 3696

more service provider processors further comprises executing computer-implemented instructions performed by one or more service provider processors for:[0008]

- transmitting a debit authorization for an amount associated with the payment request to a financial institution at which at least one of a payor deposit account or a service provider deposit account is maintained, [0035]

9. As regards claims 5 and 16, Ganesan et al discloses wherein the selected risk reduction technique is the determining that an entity is available from which to collect funds if funds cannot be collected from the payor in association with processing the payment request, and

- wherein executing computer-implemented instructions performed by one or more service provider processors further comprises executing computer-implemented instructions performed by one or more service provider processors for:[0008]

- identifying the entity from which to collect funds; wherein the payment request is processed responsive to the identification of the entity; wherein the payment is drawn on a deposit account associated with the payment

Art Unit: 3696

service provider; and

wherein the identified entity is one of the payee and a consumer service provider with which the payor is associated.[0011]

10. As regards claims 6 and 17, Ganesan et al discloses wherein the selected risk reduction technique is the determining whether payment to the payee will be drawn on a deposit account associated with the payor, or drawn on a deposit account associated with an entity other than the payor, and wherein executing computer-implemented instructions performed by one or more service provider processors further comprises executing computer-implemented instructions performed by one or more service provider processors for:[0008]

- determining at least one of i) if a monetary amount of the payment request is less than a predetermined first threshold, ii) if a total monetary amount of payments completed on behalf of the payor within a first predetermined time period is less than a predetermined second threshold, and iii) if a volume of payments completed on behalf of the payor within a second predetermined time period is less than a predetermined third threshold:[0024]
- wherein, if it is determined that the monetary amount is less than the first threshold, that the total monetary amount is less than the second threshold, or

Art Unit: 3696

that the volume is less than the third threshold, processing the payment request includes issuing one of a check or an electronic funds transfer to the payee drawn on a deposit account associated with an entity other than the payor; and[0091]

- wherein, if it is determined that the monetary amount is not less than the first threshold, that the total monetary amount is not less than the second threshold, or that the volume is not less than the third threshold, processing the payment request includes issuing a draft to the payee drawn on the payor deposit account. [0097]

11. As regards claims 7 and 18, Ganesan et al discloses wherein the assembling of the plurality of risk reduction techniques is based upon at least one of i) the identity of the payor, ii) the identity of the payee, iii) the identity of a financial institution at which the payor maintains a deposit account, iv) the identity of a consumer service provider with which the payor is associated, v) a type of payment service offered by the payment service provider utilized by the payor, (vi) the identity of a financial institution at which the payor maintains a deposit account, (vii) the payment amount, or (viii) the identity of the payment service provider.[0020; 0024]

Art Unit: 3696

12. As regards claims 8 and 19, Ganesan et al discloses wherein each of the plurality of risk reduction techniques is associated with a level of protection against financial loss to the payment service provider for processing a payment request, and wherein selecting one of the plurality of risk reduction techniques available for fulfilling the received payment request to be used when processing the payment request based at least in part on the evaluation of each risk reduction technique includes selecting the risk reduction technique that provides a highest level of protection against financial loss to the payment service provider among the plurality of risk reduction techniques available for fulfilling the received payment request.[0011;0014;0075]
13. As regards claims 9 and 20, Ganesan et al discloses wherein each of the plurality of risk reduction techniques is associated with a cost of processing a payment request, and wherein selecting one of the plurality of risk reduction techniques available for fulfilling the received payment request to be used when processing the payment request based at least in part on the evaluation of each risk reduction technique includes selecting the risk reduction technique that is associated with a least cost of processing the payment request among the plurality of risk reduction techniques for fulfilling the received payment request.[0010;0075]

Art Unit: 3696

14. As regards claims 10 and 21, Ganesan et al discloses wherein each of the plurality of risk reduction techniques is associated with a time period for processing a payment request, and wherein selecting one of the plurality of risk reduction techniques available for fulfilling the received payment request to be used when processing the payment request based on at least in part on the evaluation of each risk reduction technique includes selecting the risk reduction technique that is associated with a shortest time period to complete payment to the payee among the plurality of risk reduction techniques for fulfilling the received payment request.[0075; 0097]
15. As regards claims 11 and 22, Ganesan et al discloses wherein each of the plurality of risk reduction techniques is associated with a priority, and wherein selecting one of the plurality of risk reduction techniques available for fulfilling the received payment request to be used when processing the payment request based at least in part on the evaluation of each risk reduction technique includes selecting the risk reduction technique that is associated with the highest priority among the plurality of risk reduction techniques for fulfilling the received payment request.[0075;00080]
16. As regards claims 24 and 26, Ganesan et al discloses wherein executing computer-implemented instructions performed by one or more service provider

Art Unit: 3696

processors further comprises executing computer-implemented instructions performed by one or more service provider processors for :[0008]

- receiving, responsive to transmitting the debit authorization, one of (i)
confirmation that the payor deposit account has been successfully debited or (ii)
confirmation that the service provider account has been successfully credited.
[0035]

17. As regards claims 28 and 29, Ganesan et al discloses wherein the at least one predetermined factor associated with each of the plurality of risk reduction techniques is chosen based upon at least one of i) the identity of the payor, ii) the identity of the payment service provider, or iii) the identity of a consumer service provider with which the payor is associated. [0079]

Response to Arguments

18. Applicant's arguments filed 01/16/2009 have been fully considered but they are not persuasive. It is the examiner understands that risk processing as applied by Ganesan [0076] serves the same function as does the risk reduction techniques applied by the applicant.

Art Unit: 3696

Ganesan discloses risk processing may be based upon both past and present transactions as well as the identity of the user directing the transaction and a relationship maintained by the registered user. The processing agent 130 is capable of performing multiple types of risk processing to determine if the payment request will be accepted for execution. [0080-0084]

The claim 7 limitation states that the risk reduction techniques is based upon at least one of i) the identity of the payor, ii) the identity of the payee, iii) the identity of a financial institution at which the payor maintains a deposit account, iv) the identity of a consumer service provider with which the payor is associated, and v) a type of payment service offered by the payment service provider utilized by the payor, (vi) the identity of a financial institution at which the payor maintains a deposit account, (vii) the payment amount, or (viii) the identity of the payment service provider.

Ganesan further discloses the processing agent 130 may also perform risk analysis based upon relationships a registered user maintains.[0075] The relationship is interpreted to be referring to consumer service provider payment service provider and financial institution at which the payor maintains a deposit account.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN A. ANDERSON whose telephone number is (571)270-3327. The examiner can normally be reached on Monday through Friday 8:00 to 5:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John A Anderson/

Examiner, Art Unit 3696

John A Anderson

Examiner

Application/Control Number: 10/631,970
Art Unit: 3696

Page 13

Art Unit 3696

/J. A. A./

Examiner, Art Unit 3696 04/01/2009

/Daniel S Felten/

Primary Examiner, Art Unit 3696